

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPLICANT(s): A. NAKADA CONF NO: 1276
SERIAL NO.: 09/832,488 ART UNIT: 2145
FILING DATE: 04/11/2001 EXAMINER: BHATIA, AJAY M
TITLE: MESSAGE HANDLING METHOD, FOR MOBILE AGENT IN A
 DISTRIBUTED COMPUTER ENVIRONMENT
ATTORNEY
DOCKET NO.: 954-007861-US (DO1)

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APPELLANTS' REPLY BRIEF

(37 C.F.R. §41.41)

This is in response to the Examiner's Answer mailed on June 13, 2007 for the above-identified application.

I. The rejection of claims 7 and 18 under 35 U.S.C. 102 on Sudo.

In the first paragraph on page 5 of the Examiner's Answer, the Examiner states that appellants are importing the specification into the claim, and there is no definition of "mobile agent" in the specification. Further, the use is in one embodiment of the invention, which is not claimed, exemplification is not a definition, and the use in the specification does not depart from normal interpretation.

It is submitted that the above arguments are contradictory, i.e. if there is no definition in the specification, how can it be imported in the claims? Further, if the use in the specification does not depart from normal interpretation, why is there a requirement for a definition in the description in the first place? Appellants agree with Examiner that the terminology of the phrase "mobile agent" is very broad since it is defined as an agent which can move around a network (page 34, line 21, to page 35, line 5), but what else would a "mobile agent" be?

The Examiner has also stated in the first paragraph on page 5, that the nodes disclosed in Sudo are inherently mobile. It is submitted that there is nothing in the computer art which requires that nodes must be mobile. For something to be inherently disclosed, it must be necessarily present in the reference and it would be so recognized by persons of ordinary skill in the art (*Continental Can Co. USA Inc. v. Monsanto Co.*, 20 USPQ2d 1746, 1749). As stated above, this is not the present situation.

In the second paragraph on page 5 the Examiner states that Sudo discloses a plurality of conversation threads in Figure 2. While this is true, there is no disclosure of a conversation thread control part that is capable of controlling the plurality of conversation threads as recited in claims 7 and 18.

II. The rejection of claims 7 and 18 under 35 U.S.C. 102 on Bhanot.

In the penultimate paragraph on page 5 of the Examiner's Answer, the Examiner states that "mobile agent" is not defined in the specification. For appellants' argument on this point, see the above discussion regarding the rejection on Sudo. Further, the Examiner

states that Bhanot discloses a client computer which is inherently mobile. It is submitted that this is not true since it is well known that an agent is software and not hardware. Still further, the Examiner states that the disclosed portable computer of Bhanot is a mobile agent. But again an agent is software and not a computer. Further, "portable" (capable of being carried) is not the same as "mobile" (capable of movement but not necessarily of being carried).

The Examiner also refers to page 2, lines 15-26, of the description as disclosing conversation threads as the communication from one computer to another. This may be true, but still there is nothing in Bhanot about the claimed controlling conversation threads.

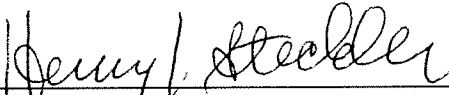
III. Additional Statements

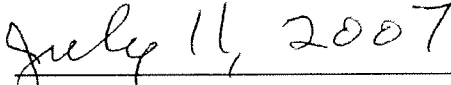
In the section titled "Appellant's additional statements" the Examiner states that "Appellant argues the combination of Sudo and Bhanot would not be obvious to one of ordinary skill in the art to combine". This apparently is a reference to the argument on page 13 of Appellants' Brief. However, it is submitted that no such argument was or could be made since, as the Examiner correctly points out, the only rejections are under 35 U.S.C. 102. As is well known, such a ground of rejection requires that only a single reference be used. In fact, what was actually argued was that since both Sudo and Bhanot are for different problems than the presently claimed invention, "...it would not be obvious to modify (not combine) Sudo or Bhanot to have a mobile agent or control thread part capable of controlling a plurality of conversation threads..." (emphasis added).

In view of the above, appellants again request a reversal of the rejection of claims 7 and 18 by this Honorable Board.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 50-0510.

Respectfully submitted,


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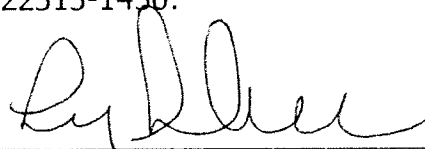
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